

REMARKS

The Examiner's Action mailed on October 18, 2004, has been received and its contents carefully considered.

In this Amendment, Applicant has amended independent claim 1 to include the subject matter of dependent claim 10, and has canceled claim 10. Claim 1 is the independent claim, and claims 1 and 4-9 remain pending in the application. For at least the following reasons, it is submitted that this application is in condition for allowance.

The Examiner's Action has rejected claims 1, 4-6 and 10 as being anticipated by *Ishitsuka et al.* (USP 6,242,323). Because claim 10 has been canceled and the subject matter recited therein incorporated into independent claim 1, Applicant will treat this rejection as pertaining to only claims 1 and 4-6. It is submitted that these claims are *prima facie* patentably distinguishable over the cited reference for at least the following reasons.

It is well settled that a reference may anticipate a claim within the purview of 35 U.S.C. § 102 only if all the features and all the relationships recited in the claim are taught by the referenced structure either by clear disclosure or under the principle of inherency.

Applicant's independent claim 1 is directed to a method of fabricating a semi-conductor device having trenches which includes, *inter alia*, a second oxide film forming step that is performed through a third insulating film after the third insulating film is deposited. The second oxide film forming step is comprised of

subjecting a semiconductor substrate at a cornered portion of each trench to thermal oxidation, thereby forming a second oxide film. The second oxide forming step includes supplying oxygen from an upper side of the third insulating film so that the oxygen is diffused into the third insulating film and so that an oxidative reaction starts at the cornered portion. This claimed method is neither disclosed nor suggested by the cited reference.

In rejecting Applicant's dependent claim 10, now amended into independent claim 1, the Examiner's Action relies on column 2, lines 1-15 of the cited reference. However, it is initially noted that these passages refer to the prior art configuration shown in Figures 1A through 1D. Thus, the Examiner's Action appears to be combining the prior art configuration shown in Figures 1A through 1D, with the embodiment shown in Figures 2A through 2E and Figures 51 through 54, which features were used in rejecting original independent claim 1. However, the Examiner's attention is directed to the fact that such combining of features would only be proper in establishing a Section 103 rejection. Such combination of embodiments is impermissible in establishing an anticipation type rejection.

Moreover, it is also noted that the cited reference specifically states that the prior art configuration discussed in column 2, lines 1-15 is problematic. Thus, even if the Examiner's Action had rejected original dependent claim 10 under Section 103, one skilled in the art would have had no motivation to have combined the prior art configuration discussed in lines 1-15 of column 2, with the embodiment shown in Figures 2A through 2E and Figures 51 through 54. Thus,

even assuming that the rejection was based on Section 103, one can logically conclude that it is only in view of Applicant's disclosure that such a modification would be desirable.

Moreover, it is also noted that the prior art configuration discussed in column 2, lines 1-15 only teaches utilizing wet or steam oxidation for sintering a silicon oxide film 36 which is imbedded in a groove. However, this reference does not disclose or otherwise suggest supplying oxygen from an upper side of a third insulating film, as now recited within Applicant's independent claim 1. Moreover, there is no disclosure or suggestion from these passages of oxygen being diffused into a third insulating film as recited by Applicant's independent claim 1. In fact, column 2, lines 1-15 is entirely silent about any sort of third insulating film whatsoever. Moreover, these passages do not disclose or otherwise suggest that an oxidative reaction starts at a cornered portion, as recited by Applicant's independent claim 1. As such, it is submitted that Applicant's independent claim 1 and the claims dependent therefrom are *prima facie* patentably distinguishable over the cited reference. It is thus requested that these claims be allowed and that these rejections be withdrawn.

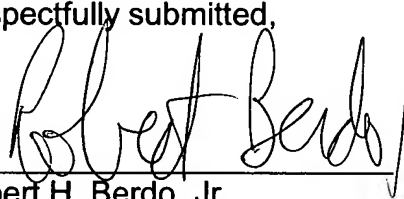
The Examiner's Action has also rejected claims 7-9 as being obvious over *Ishitsuka et al.* in view of *Watanabe* (USP 6,417,073). Because *Watanabe* does not overcome the above-noted deficiencies of *Ishitsuka et al.* and because claims 7-9 depend from independent claim 1, it is submitted that these claims are *prima facie* patentably distinguishable over the cited references for at least the same

reasons as independent claim 1, from which these claims depend, as well as for the additional features recited therein. It is thus requested that these claims be allowed and that these rejections be withdrawn.

It is submitted that this application is in condition for allowance. Such action and the passing of this case to issue are requested.

Should the Examiner feel that a conference would help to expedite the prosecution of this application, the Examiner is hereby invited to contact the undersigned counsel to arrange for such an interview.

Respectfully submitted,



January 18, 2005

Date

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